UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/666,653	06/18/96	HONDA T	024060-064

EXAMINER	
MOE, A	
ART UNIT	**PAPER NUMBER**
2712	22

DATE MAILED: 07/06/00

021839 LM02/0706
BURNS DOANE SWECKER & MATHIS
P O BOX 1404
ALEXANDRIA VA 22313-1404

Please find below and/or attached an Office communication concerning this application or proceeding.

See Attached.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
08/666,653	Honda et al.
Examiner	**Group Art Unit**
Aung S. Moe	2712

☒ Responsive to communication(s) filed on *Apr 27, 2000*

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *1-26, 29, and 30* is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☒ Claim(s) *19-26* is/are allowed.

☒ Claim(s) *1-18, 29, and 30* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on April 27, 2000 have been fully considered but they are not persuasive.

In pages 2+ of the remarks, the Applicant argues that "Inoue does not disclose or suggest a video signal recording section for recording a video signal obtained by the video picture shooting section and video information on a video recording medium, the video information relating to the shooting of the video picture, wherein the video signal recording section stores still pictures and motion pictures on the video recording medium, the still pictures being distinguished from the motion pictures based on the video information which is stored in a data area of the video recording medium."

In response to applicant's arguments above, it is noted that the applicant is arguing against the references individually, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skill in the art would be motivated to make the proposed combination of primary and secondary references. Moreover, the test for combining references is what the combination of disclosures taken as a whole suggest to one ordinary skill in the art, thus, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In this case, the Examiner noted the deficiencies of the primary reference (i.e., see the rejection below), moreover, the Examiner further provided the second references (i.e., Kori and Wash references) to show that such deficiencies of Inoue are well-known in the art. Furthermore, the Examiner has set forth in Paper No. 18 reasons why one skilled in the art, and therefore possessing knowledge generally available to the skilled artisan, would have been motivated to combine the cited references.

As stated above, The Applicant's argument is expressed only against the single references (i.e., Inoue) and does not specifically set forth reasons why the cited references should not be combined for the reasons set forth in the last Office Action.

In view of this, the Examiner continues to be the opinion that one skilled in the art would have been prompted to combine the cited references for the reasons set forth in the 103 rejections, thus, the Examiner believes that the combination of references as stated in the Last Office Action is proper, and the explanations of how the limitation of the present claimed invention read on the proposed combination of the cited references (i.e., Inoue in view of Kori/Wash) are adequately set forth in the 103 rejections as stated in the Last Office Action and this Office Action as follows:

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-7 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue (U.S. 5,710,954) in view of Kori et al. (U.S. 5,513,010).

Regarding claim 1, Inoue '954 discloses a camera which includes both sliver salt and video recording capabilities. Therefore, the Inoue '954 camera includes a liver salt picture shooting section, a video picture shooting section and a video signal recording means. In col. 9, lines 25+, Inoue '954 states that information relating to the picture can be stored on the film along with the image and the use of a video recording medium (i.e., the recording unit 125 for storing the moving pictures).

Furthermore, it is noted that Inoue '954 does not explicitly show that the video signal recording means is capable of recording information relating to the picture (i.e., time/date, and ID data) along with the signal on the video recording means, and further stored the still and motion pictures on the video recording medium, and the still pictures being distinguished from the motion pictures based on the video information which is stored in a data area of the video recording medium and reproducing the video signal and video information from the recording medium, wherein still picture are identified by video information stored in the data area of the video recording medium as specified in claim 1.

However, the above mentioned claimed limitations are well-known in the art as evidenced by the teaching of Kori '010. In this case, Kori '010 teaches that in the digital video signal recording and reproducing system (Figs. 2 and 25), it is well-known to record/reproduce such information relating to the picture (i.e., time/date, and ID data) along with the signal on the video recording means (i.e., Figs. 5C-6B, 14A-14E, 17 of Kori '010), and Kori '010 further teaches that the still pictures and motion pictures are stored on the video recording medium (Figs. 30A-30C, 32A-33F; col. 17 & 18, lines 20+), and the still pictures being distinguished from the motion pictures based on the video information which is stored in a data area of the video recording medium and reproducing the video signal and video information from the recording medium (i.e., noted that INDEX ID signals are stored on the recording medium for distinguishing the motion and still pictures; see col. 15, lines 25+ of Kori '010), wherein still picture are identified by video

information stored in the data area of the video recording medium (col. 19, lines 4+) as specified in claim 1.

In view of the above, having the system of Inoue '954 and then given the well-established teaching of Kori '010, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Inoue '954 as taught by Kori '010, since Kori '010 states at column 1, lines 50+ that such a modification would provide the capability of high speed cuing of both still pictures and moving pictures thereof.

Moreover, the rest of the rejection of claim 1 and the rejection of claims 2-7 are set forth in the previous Office action (please see paper no. 7 & 12).

As for new claim 29, it is noted that the combination of Inoue '954 and Kori '010 shows control logic for searching recording medium based on an index to retrieve a previously captured still picture to be edited and the associated video information (i.e., see the elements 26-27, 29-30 & col. 21, lines 50-68 of Inoue '954 and the elements 85 and Figs. 35-38, col. 6, lines 45+), said previously captured still pictures to be edited and associated video information being associated with a still picture captured on the silver salt based (i.e., noted that Inoue '954 shows that previously captured still picture and associated video information being associated with a still picture captured on the silver salt-based medium; see col. 14, lines 40+, col. 21, lines 50+ and Kori '010 teaches the searching of the previously captured still picture base on the index to retrieve for editing purposes; see Figs. 35-38 of Kori '010);

control logic for displaying a first screen presenting the previously captured still picture to be edited, coupled with the associated video information; and displaying a second screen for editing the video information associated with the previously captured still picture (see Figs. 7, 19, 20, 23, 28, 30A-30C of Inoue '954 and col. 18, lines 30+ of Kori '010).

Therefore, claim 29 is obvious over Inoue '954 in view of Kori '010 for at least the reasons discussed above.

Since claim 30 correspond to claims 1-7, claim 30 is analyzed as previously discussed with respect to claims 1-7 as previously discussed.

4. Claims 8-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue '954 in view of Wash (U.S. 4,974,096).

As for claim 8, it is considered equivalent to claim 1 with the additional limitations to an identification number being identified with the film and an index recording section for searching the recording medium for separately stored information pertaining to silver salt shooting information, and for collecting together and recording index data thereof.

In this case, Inoue '954 shows in figure 1 and "film information detecting unit" (24) which is capable of detecting information about the film (col. 6, lines 59+). Although Inoue '954 does not explicitly state that such information can include an "ID" number of the film and the frame number, Inoue '954 does use the open phrase "or the like" which leaves the disclosure open to include any kind of information which would have been obvious to one of ordinary skill in the art.

Moreover, An ID number would have been obvious since it uniquely identifies the film being used so that it can be accessed quickly and appropriately in post-processing (i.e., noted the element 236 of Fig. 25). Furthermore, the frame number would have been equally obvious, since in any post-processing, the processor would need to know which frame number was being processed in order to know how to process it.

In addition, the broadest reasonable interpretation of the index recording section reads on the aggregate of information which is stored on the film along with each photograph (see Fig. 4), thus, the magnetic recording layer along the top of the film can be considered as the "index data recording section."

To further support the Examiner's position, Wash '096 reference is cited to show the obvious teaching of the above mentioned claimed limitations. Moreover, Wash '096 teaches the use of a silver salt film individual identification number/frame number in the image shooting apparatus for outputting an individual identification number and a frame number of the silver salt film used as a recording medium for the silver salt picture shooting section (see Fig. 2; col. 10, line 30-col. 11, line 68);

and index data recording section for searching the recording medium for separately stored information pertaining to silver salt shooting information, and for collecting together and recording index data which forms an aggregate of the separately stored silver salt shooting information as specified in claim 8 (see Figs. 5-7, col. 6, lines 65+; col. 8, lines 15+; col. 9, lines 10+).

In view of the above, having the system of Inoue '954 and then given the well-established teaching of Wash '096, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Inoue '954 as taught by Wash '096, since Wash '096 states at column 2, lines 55+ that such a modification would enable to quickly read a particular desired piece of information for a particular frame without undue searching through or reading other data to find the one desired pieces.

As for dependent claims 9-18, these claims were treated in the previous Office action (please see paper no. 7 & 12).

5. Claims 19-26 are allowed for the reasons set forth in the previous Office action (please see paper no. 7 & 12).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or Faxed to:

(703) 308-6306

or:

(703) 308-6296, (for formal communications; please mark "**EXPEDITED PROCEDURE**"; and for informal or draft communications, please label "**PROPOSED**" or "**DRAFT**").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Aung S. Moe** whose telephone number is (703) 306-3021. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wendy Garber**, can be reach on (703) 305-4929.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Wendy Garber
Supervisory Patent Examiner
Technology Center 2700

A. Moe

July 1, 2000